

**REMARKS**

**INTRODUCTION:**

In accordance with the foregoing, claims 1, 7, 13, 15, 16, 19 and 25 have been amended, and claims 6, 14, and 18 have been cancelled without prejudice or disclaimer. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1-7, 9-13, 15-17, 19, and 21-30 are pending and under consideration. Reconsideration is respectfully requested.

**ENTRY OF RESPONSE UNDER 37 C.F.R. §1.116:**

Applicant requests entry of this Rule 116 Response and Request for Reconsideration because:

(a) at least certain of the rejected claims have been canceled thereby at least reducing the issues for appeal;

(b) it is believed that the amendments of claims 1, 7, 13, 15, 16, 19 and 25 puts this application into condition for allowance;

(c) the amendments were not earlier presented because the Applicant believed in good faith that the cited prior art did not disclose the present invention as previously claimed;

(d) the amendments of claims 1, 7, 13, 15, 16, 19 and 25 should not entail any further search by the Examiner since no new features are being added or no new issues are being raised; and/or

(e) the amendments place the application at least into a better form for appeal. No new features or new issues are being raised.

The Manual of Patent Examining Procedures sets forth in §714.12 that "[a]ny amendment that would place the case either in condition for allowance or in better form for appeal may be entered." (Underlining added for emphasis) Moreover, §714.13 sets forth that "[t]he Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

**REJECTION UNDER 35 U.S.C. §103:**

A. In the Office Action, at pages 2-3 and 5, numbered paragraphs 2 and 4, claims 1-4, 6, 7, 9, 13-16, 18, 19, 21, 25-28 and 30 were rejected under 35 U.S.C. §103(a) as being obvious

over Hishiyama (JP 1-305231; hereafter, Hishiyama) in view of Yang et al. (USPN 5,990,467; hereafter, Yang) or Shin (USPN 6,005,235; hereafter, Shin) and Ikeda (JP 62-297634; hereafter, Ikeda). The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

Independent claims 1, 13 and 25 have been amended to show more clearly differences between the present claimed invention and the cited references.

It is respectfully submitted that the Examiner is, without good cause, suggesting combining **FOUR** references to obtain the present invention. In Ruiz and Foundation v. A.B. Chance Company, 69 USPQ2d 1690 (CAFC January 29, 2004), the court held that inventions must be viewed as a whole, not simply taken apart, piece by piece, and each piece then located in a granted patent:

In making the assessment of differences, section 103 specifically requires consideration of the claimed invention "as a whole." **Inventions typically are new combinations of existing principles or features.** Env'tl. Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that "virtually all [inventions] are combinations of old elements."). **The "as a whole" instruction in title 35 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result – often the very definition of invention.** (emphasis added)

Section 103 precludes this hindsight discounting of the value of new combinations by requiring assessment of the invention as a whole. This court has provided further assurance of an "as a whole" assessment of the invention under § 103 by requiring a showing that an artisan of ordinary skill in the art at the time of invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would select the various elements from the prior art and combine them in the claimed manner. In other words, the examiner or court must show some suggestion or motivation, before the invention itself, to make the new combination. See In re Rouffet, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998).

Hishiyama recites improving the heating effect of an electric heater in a cooking apparatus in which a microwave oven and a toaster are integrated by causing the electric heater circuit to extend the heating time in proportion to the simultaneous electrical supply time where electricity is supplied to the heating circuits for both heating units simultaneously. That is, the operation of the microwave oven and operation of the toaster are operated in concert, the operation time of the microwave oven being related to the operation time of the toaster; the toaster heating is continuously monitored, and, for example, when the microwave oven is used during the toaster heating, the remaining time for toaster heating is doubled. Also, as admitted

by the Examiner, Hishiyama does not explicitly identify the electrical components in the electrical machine room. In contrast, in the present invention, the toaster portion is operated independently of the microwave oven portion. Thus, Hishiyama teaches away from the present invention.

Although Yang recites a device chamber with various electric elements such as a magnetron and a blower for cooling elements installed in the device chamber, Yang does not recite: a microwave oven, comprising: a cabinet partitioned into a microwave cooking cavity, a toasting cavity, and a machine room, as is recited in independent claim 1 of the present invention; a microwave generating unit located in a first cavity to generate microwaves into a second cavity adjacent to the first cavity and at least one heating unit located in a third cavity proximate to the second cavity as recited in independent claim 13 of the present invention; or a method of combining toasting and microwave cooking in a microwave oven, comprising: partitioning a cabinet into a microwave cooking cavity, a toasting cavity, and a machine room, as is recited in independent claim 25 of the present invention. In addition, Yang does not disclose separate doors for separate toasting and microwaving cavities. Thus, it is respectfully submitted that Yang recites a different construction than the construction of the present invention, and there is no teaching or suggestion of combining Yang with Hishiyama. Since Hishiyama teaches away from the present invention, even if Yang and Hishiyama were combined, the combination would not teach the present invention.

Shin recites a microwave oven having a single cavity that does not implement a toasting unit. Thus Shin teaches away from the present invention, which recites a microwave oven, comprising: a cabinet partitioned into a microwave cooking cavity, a toasting cavity, and a machine room, as is recited in independent claim 1 of the present invention; a microwave generating unit located in a first cavity to generate microwaves into a second cavity adjacent to the first cavity and at least one heating unit located in a third cavity proximate to the second cavity as recited in independent claim 13 of the present invention; or a method of combining toasting and microwave cooking in a microwave oven, comprising: partitioning a cabinet into a microwave cooking cavity, a toasting cavity, and a machine room, as is recited in independent claim 25 of the present invention. There is no teaching or suggestion of combining Shin with Hishiyama or Yang, and even if combined, the combination would not recite the present invention (see above arguments). In addition, as admitted by the Examiner, the combination does not show the use of the ventilation unit for venting the toasting cavity.

Applicant respectfully disagrees with the Examiner with respect to the number of cavities provided in the microwave oven. Ikeda recites a single cooking chamber with a single cavity in which a rack may be positioned at a desired height. That is, two separate cavities are not provided in the structure of Ikeda, as may be seen in FIG. 2 of Ikeda. In addition, Ikeda does not

disclose separate doors for separate toasting and microwaving cavities. Also, as may be seen in FIG. 2 of Ikeda, a single fan is utilized to ventilate the heating cavity, in contrast to the present invention, which utilizes one fan for the toasting cavity and another fan for cooling the high-voltage transformer and the high-voltage condenser. Thus, in the present invention, the cooling fan for the high-voltage transformer and the high-voltage condenser may be operated, for example at a higher speed to maintain a cool temperature for the machine parts, and the cooling fan for the toasting cavity may be operated at a different speed, as desired. Hence, Ikeda does not recite the present claimed invention, and even if combined with Hishiyama, Yang and/or Shin, the combination does not recite the present invention.

Thus, it is respectfully submitted that the Examiner's attempt to join elements of Hishiyama, Yang and/or Shin and Ikeda does not provide the present invention, and such a combination is not permissible since breaking an invention into its component parts (A + B + C), then finding a prior art reference containing A, another containing B, and another containing C, and on that basis alone declaring the invention obvious is not permitted.

Hence, it is respectfully submitted that amended claims 1, 13 and 25 are patentable under 35 U.S.C. §103(a) over Hishiyama (JP 1-305231) in view of Yang et al. (USPN 5,990,467) or Shin (USPN 6,005,235) and Ikeda (JP 62-297634). Since claims 2-4, 7, 9, 13, 15-16, 19, 21, 25-28 and 30 depend from amended claims 1, 13 and 25, respectively, claims 2-4, 7, 9, 13, 15-16, 19, 21, 25-28 and 30 are submitted to be patentable under 35 U.S.C. §103(a) over Hishiyama (JP 1-305231) in view of Yang et al. (USPN 5,990,467) or Shin (USPN 6,005,235) and Ikeda (JP 62-297634) for at least the reasons that amended claims 1, 13 and 25 are submitted to be patentable under 35 U.S.C. §103(a) over Hishiyama (JP 1-305231) in view of Yang et al. (USPN 5,990,467) or Shin (USPN 6,005,235) and Ikeda (JP 62-297634).

B. In the Office Action, at pages 4 and 5, numbered paragraphs 3 and 4, claims 5, 10-12, 17, 22-24, and 29 were rejected under 35 U.S.C. §103(a) as being obvious over Hishiyama (JP 1-305231; hereafter, Hishiyama) in view of Yang et al. (USPN 5,990,467; hereafter, Yang) or Shin (USPN 6,005,235; hereafter, Shin) and Ikeda (JP 62-297634; hereafter, Ikeda) as applied to claims 1-4, 6, 7, 9, 13-16, 18, 19, 21, 25-28 and 30 above, and further in view of Nitta (JP 55-110835; hereafter, Nitta) or Yoshikawa (JP 4-148115; hereafter, Yoshikawa). The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

Independent claims 1, 13 and 25 have been amended to show more clearly differences between the present claimed invention and the cited references.

Neither Nitta nor Yoshikawa, alone or in combination, teaches or suggests the use a ventilating fan to ventilate the toasting cavity and a cooling fan to cool the high-voltage

transformer and the high-voltage condenser, as is recited by the present claimed invention in amended claims 1, 13 and 25.

Nitta discloses only one heating cavity (see FIG. 2 of Nitta). Hence, it is respectfully submitted that Nitta teaches away from the present invention since Nitta does not recite utilizing of a toasting cavity, as is recited in the present invention. Hence, there is no teaching or suggestion of combining Nitta with Hishiyama, Yang or Shin and Ikeda as applied to claims 1-4, 6, 7, 9, 13-16, 18, 19, 21, 25-28 and 30 above. Even if Nitta were combined with Hishiyama, Yang or Shin and Ikeda, the combination would not recite the present claimed invention.

Yoshikawa also discloses only one heating cavity (see FIG. 1 of Yoshikawa). Hence, it is respectfully submitted that Yoshikawa teaches away from the present invention since Yoshikawa does not recite utilizing of a toasting cavity, as is recited in the present invention. Hence, there is no teaching or suggestion of combining Yoshikawa with Hishiyama, Yang or Shin, Ikeda and Nitta as applied to claims 1-4, 6, 7, 9, 13-16, 18, 19, 21, 25-28 and 30 above. Even if Yoshikawa were combined with Hishiyama, Yang or Shin, Ikeda, and Nitta, the combination would not recite the present claimed invention (see above arguments).

Thus, it is respectfully submitted that amended claims 1, 13 and 25 are patentable under 35 U.S.C. §103(a) over Hishiyama (JP 1-305231) in view of Yang et al. (USPN 5,990,467) or Shin (USPN 6,005,235) and Ikeda (JP 62-297634) as applied to claims 1-4, 6, 7, 9, 13-16, 18, 19, 21, 25-28 and 30 above, and further in view of Nitta (JP 55-110835) or Yoshikawa (JP 4-148115). Since claims 5, 10-12, 17, 22-24, and 29 depend from amended claims 1, 13 and 25, respectively, claims 5, 10-12, 17, 22-24, and 29 are submitted to be patentable under 35 U.S.C. §103(a) over Hishiyama (JP 1-305231) in view of Yang et al. (USPN 5,990,467) or Shin (USPN 6,005,235) and Ikeda (JP 62-297634) as applied to claims 1-4, 6, 7, 9, 13-16, 18, 19, 21, 25-28 and 30 above, and further in view of Nitta (JP 55-110835) or Yoshikawa (JP 4-148115) for at least the reasons that amended claims 1, 13 and 25 are submitted to be patentable under 35 U.S.C. §103(a) over Hishiyama (JP 1-305231) in view of Yang et al. (USPN 5,990,467) or Shin (USPN 6,005,235) and Ikeda (JP 62-297634) as applied to claims 1-4, 6, 7, 9, 13-16, 18, 19, 21, 25-28 and 30 above, and further in view of Nitta (JP 55-110835) or Yoshikawa (JP 4-148115).

#### **CONCLUSION:**

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for

allowance which action is earnestly solicited. At a minimum, this Amendment should be entered at least for purposes of Appeal as it either clarifies and/or narrows the issues for consideration by the Board.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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